

In re: John Weldon Gammon *et al.*
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REMARKS

Applicants appreciate the Office Action of November 2, 2005. In particular, Applicants appreciate the Examiner's indication that Claims 34-37 are allowed and Claims 12-25, 27-29 and 31 would be allowable if rewritten in independent form. Applicants submit the finality of the rejection is improper as Claim 1 was amended in Applicants' previous Amendment to include recitations of dependent Claim 5 and Claim 5 was cancelled from the present application. Applicants further submit that the pending claims are patentable over the cited references for at least the reasons discussed herein.

The Finality of the Office Action is Improper

Applicants submit that Applicants' Amendment filed on September 6, 2005 did not necessitate the new grounds of rejection and, therefore, the finality of the present Office Action is improper.

In response to the Office Action of June 3, 2005, Independent Claim 1 was amended to incorporate the recitations of cancelled Claim 5.

The present Office Action of November 2, 2005 contains an anticipation rejection based on new portions of the cited art, an obviousness rejection combining the previously cited references and makes this rejection final. However, Applicants respectfully submit that the finality of this rejection is premature, because the previous amendments to the independent claim merely incorporated recitations of existing claims. Thus, a new search was not necessitated by Applicants' Amendment.

As noted by MPEP 706.07:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to

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defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.

While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application. But the applicant who dallies in the prosecution of his or her application, resorting to technical or other obvious subterfuges in order to keep the application pending before the primary examiner, can no longer find a refuge in the rules to ward off a final rejection.

Accordingly, should the present Request for Reconsideration After Final not change the Examiner's position with respect to the pending claims, Applicants respectfully request withdrawal of the finality of the Office Action of November 2, 2005, so that Applicants have a fair opportunity to prosecute this application before the Examiner.

The Section 102 Rejections

Claims 1-2, 6-11 and 30 stand rejected under 35 U.S.C. § 102(e) as being anticipated by United States Patent Publication No. 2004/0023697 to Komura (hereinafter "Komura"). See Final Office Action, page 2. Applicants respectfully submit that many of the recitations of these claims are neither disclosed nor suggested by Komura. For example, Claim 1 recites:

A mobile terminal comprising:
a housing;
an electronic circuit positioned in the housing;
a first speaker positioned adjacent a first side of the electronic circuit;
a second speaker positioned adjacent the first speaker on the first side of the electronic circuit; and
a grommet positioned in the housing that is configured to receive the first speaker and the second speaker, wherein the first speaker and the second speaker are positioned in the grommet.

Applicants submit that at least the highlighted recitations of Claim 1 are neither disclosed nor suggested by Komura.

The Final Office Action states that Figure 2 and paragraphs 0131 and 0136 of Komura

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teach the highlighted recitations of Claim 1. *See* Final Office Action, page 3. However, the cited portion of Komura discusses positioning of acoustic loudspeakers 2a and 2b as illustrated in Figure 2. Nothing in the cited portion of Komura discloses or suggests positioning the acoustic loudspeakers 2a and 2b in a grommet. In fact, nothing in Komura appears to mention the use of a grommet in any of the embodiments discussed therein.

Under 35 U.S.C. § 102, "a claim is anticipated only if each and every element as set forth in the claim is found, *either expressly or inherently* described, in a single prior art reference." M.P.E.P. § 2131 (quoting *Verdegaal Bros. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987)). "The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" M.P.E.P. § 2112 (citations omitted). Thus, as nothing in Komura discloses or suggests a grommet, this silence does not establish inherency. Furthermore, nothing in Komura appears to suggest the use of a grommet.

Accordingly, Applicants respectfully submit that Claim 1 is patentable over Komura for at least the reasons discussed herein. Furthermore, the dependent claims are patentable at least per the patentability of independent Claim 1 from which they depend.

Many of the dependent claims are also separately patentable. The rejections of the dependent claims in the Final Office Action appear to be identical to the rejections in the previous Office Action of June 3, 2005. In fact, the Final Office Action still contains a rejection of Claim 5 (Final Office Action, page 3), even though Applicants cancelled Claim 5 in Applicants' previous Amendment of September 6, 2005. Thus, Applicants submit that the dependent claims are patentable for at least the reasons discussed in Applicants' Amendment of September 6, 2005. Applicants will not repeat the Arguments made therein, in the interest of brevity, but the arguments are incorporated herein as if set forth in their entirety.

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B. Many of the Dependent Claims are also Separately Patentable

Claims 3-4 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Komura in view of United States Patent Publication No. 2003/0095680 to Kim (hereinafter Kim). Claim 26 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Komura in view of United States Patent No. 5,201,069 to Barabolak. Claim 32 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Komura in view of United States Patent Publication No. 2003/0003879 to Saiki. Claim 33 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Komura in view of United States Patent Publication No. 2002/0042287 to Asami. As discussed above, these dependent claims are patentable at least per the patentability of independent base Claim 1 from which they depend. However, many of these claims are also separately patentable.

The rejections of the dependent claims in the Final Office Action appear to be identical to the rejections in the previous office action of June 3, 2005. Thus, Applicants submit that the dependent claims are patentable for at least the reasons discussed in Applicants' Amendment of September 6, 2005. Applicants will not repeat the Arguments made therein, in the interest of brevity, but the arguments are incorporated herein as if set forth in their entirety.

CONCLUSION

Applicants respectfully submit that the pending claims are patentable over the cited references for at least the reasons discussed herein. Accordingly, Applicants respectfully submit that the pending claims are in condition for allowance, which is respectfully requested in due course.

Respectfully submitted,



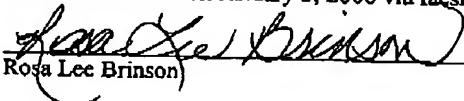
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